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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/337,113	06/21/1999	ESKO HANNULA	NC273315	8541

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EXAMINER

ABDI, KAMBIZ

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 08/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/337,113

Applicant(s)

HANNULA, ESKO

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 17, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

1. Claims 1-10, and 14-20 have been examined.

Drawings

2. The corrected or substitute drawings were received on May 17, 2002. These drawings entered as paper no. 6.

Specification

3. Corrected specification received on May 17, 2002 has been entered.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 17 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 17 is not clear on what the applicant intended by the statement "of providing the indicia of..." For the purpose of examination, the examiner will interpret the claim as "an operation to provide the indicia".

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-10, 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,223,291 to Larry C. Puhl in view of U.S. Patent No. 6,331,972 to Jeffery Martin Harris and U.S. Patent No. 6,282,522 to Vigil M. Davis.

7. As for claims 1 and 15, Puhl discloses an apparatus and method for;

a recipient-terminal downloading connector selectably operable to effectuate a communication link with the provider mobile terminal when the recipient mobile terminal and the provider mobile terminal are positioned in the manner permitting the communication connectivity there together and selectably operable to effectuate a communication link with the remotely-positioned payment account depository (See Puhl Abstract, figure 3-5, and col. 11, ln. 5-68, col. 12, ln. 1-10, col. 13, ln. 25-68, and col. 14 ln. 1-12);

a credit payment indicator for containing at least an indicia of creditworthiness of the recipient-terminal user (See Puhl Abstract, figure 3-5, and col. 11, ln. 5-68, col. 12, ln. 1-10, col. 13, ln. 25-68, and col. 14 ln. 1-12); and

a downloading controller coupled to said payment indicator and to said downloading connector, said downloading controller for permitting said recipient-terminal downloading connector to effectuate the communication link with the provider terminal, thereby to download the content to the recipient mobile terminal if said payment indicator indicates the indicia of creditworthiness to be beyond at least a selected threshold, said downloading controller further, subsequent to downloading of the content to the recipient mobile terminal, for causing said recipient-terminal downloading connector to effectuate the communication link with the payment account depository to permit effectuation of debiting of the indicia of creditworthiness to the benefit of the payee entity and, upon debiting, to permit the execution of the content at the recipient mobile terminal (See Puhl Abstract, figure 3-5, and col. 11, ln. 5-68, col. 12, ln. 1-10, col. 13, ln. 25-68, and col. 14 ln. 1-12).

But, Puhl does not clearly specify "mobile provider terminal", as recited above. However, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to make both the receiving and provider terminals portable In re Lindberg 93 USPQ 23 (CCPA 1952). Since

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by doing so, it would make any terminal to be moved about easily and terminals can be characterized as being small and light, making their transportation very easy. (Additionally, Harris does disclose a system that works based on a peer-to-peer communication and transaction).

Further, what Puhl is not explicit about is the nature of the "Smart Card's" value holding and a system that it does utilize to transact the transfer of "electronic cash" from the receiving terminal to the provider terminal. However, both Harris and Davis clearly teach systems that use smart card and cash value stored within them to carry on "electronic cash" transaction (See Harris col. 21, ln. 60-68 and col. 22, ln. 1-55, and Davis figure 32, col. 23, ln. 66-68 and col. 24, ln. 1-23). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the two concepts to have a quicker and easier transaction process over an open network.

8. As for claim 2, Puhl, Harris and Davis disclose the apparatus of claim 1, further; what Puhl does not clearly disclose is that the provider mobile terminal comprises a provider-terminal downloading connector and wherein said recipient-terminal downloading terminal is engageable the provider-terminal downloading connector. It would be inherent in this type of peer to peer systems for both peers to have the same relevance, they must be able to communicate, this communication would require certain connectivity either physical or not. Puhl describes a method that uses WAP to establish communication between the two parties. (See Puhl col. 9, ln. 1-8 and ln. 22-28).

But, Puhl does not clearly specify "mobile provider terminal", as recited in claims 1 and 15. However, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to make both the receiving and provider terminals portable In re Lindberg 93 USPQ 23 (CCPA 1952). Since by doing so, it would make any terminal to be moved about easily and terminals can be characterized as being small and light, making their transportation very easy. (Additionally, Harris does disclose a system that works based on a peer-to-peer communication and transaction).

9. As for claim 3, Puhl, Harris and Davis disclose the apparatus of claim 2, further;

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what Puhl does not clearly disclose is that a point-to-point connection is formed between the provider mobile terminal and the recipient mobile terminal when the provider-terminal downloading connector engages with said recipient-terminal downloading connector. As for Puhl not clearly specifying "mobile provider terminal", as recited in claims 2 and 1. However, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to make both the receiving and provider terminals portable In re Lindberg 93 USPQ 23 (CCPA 1952). Since by doing so, it would make any terminal to be moved about easily and terminals can be characterized as being small and light, making their transportation very easy, which in turn would lead to the capability of out most availability of the provider terminal a distribution point. (Additionally, Harris does disclose a system that works based on a peer-to-peer communication and transaction).

Even though Puhl dose not explicitly teach this but it is obvious to one having ordinary skill in the art at the time the current invention was made, that two entities peered as such in this invention must be able to exchange (push and pull or down-load) information between them. This transaction between to terminals need to be controlled (See Puhl Abstract, figure 3-5, and col. 11, ln. 5-68, col. 12, ln. 1-10, col. 13, ln. 25-68, and col. 14 ln. 1-12).

10. As for claim 4, Puhl, Harris and Davis disclose the apparatus of claim 3, further; what Puhl does not clearly disclose is that the provider-terminal downloading connector and said recipient-terminal downloading connector each comprise executable downloader programs. But Puhl is clear of at least one of the terminals having an executable program at the point of contact to manage the information transfer and other related execution of task regarding a transaction (See Puhl Abstract, figure 3-5, and col. 11, ln. 5-68, col. 12, ln. 1-10, col. 13, ln. 25-68, and col. 14 ln. 1-12). Additionally, it is well know to one having ordinary skill in the art at the time the current invention was made, that any two terminals in order to interact with each other they must have to communicate, thus it requires the two terminals to have the appropriate software and modes of linkage be it physical or otherwise, for communication and downloading digital assets.

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11. As for claim 5, Puhl, Harris and Davis disclose the apparatus of claim 1, further; what Puhl clearly discloses, is that said recipient-terminal downloading connector comprises an executable downloader program, executable at the recipient mobile terminal (See Puhl Abstract, figure 3-5, and col. 11, ln. 5-68, col. 12, ln. 1-10, col. 13, ln. 25-68, and col. 14 ln. 1-12). Additionally, it is well know to one having ordinary skill in the art at the time the current invention was made, that any two terminals in order to interact with each other they must have to communicate, thus it requires the two terminals to have the appropriate software for communication and downloading digital assets.

12. As for claim 6, Puhl, Harris and Davis disclose the apparatus of claim 1, further; Puhl does disclose that the content executable at the provider mobile terminal comprises a selected application program selected from amongst a plurality of application programs and wherein said recipient terminal downloading connector is actuable by the recipient-terminal user to select the selected application program from amongst the plurality of application programs (See Puhl Abstract, figure 3-5, and col. 11, ln. 5-68, col. 12, ln. 1-10, col. 13, ln. 25-68, and col. 14 ln. 1-12).

13. As for claim 7, Puhl, Harris and Davis disclose the apparatus of claim 1, further; what Puhl does not clearly disclose is that payment indicator is releasably engageable with the recipient mobile terminal, coupled to said downloading controller when engaged with the recipient mobile terminal. What Puhl is not explicit about is the nature of the SIM card present in the client system and what content does it carry. In addition, Davis is clear about the role of the Smart Cards in "online" transactions and how it can expedite the speed of the transaction. (See Davis figure 1 and 2, and col. 7, ln. 5-35). However, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to incorporate Davis's teaching within Puhl's invention for flexibility of using smart cards rather than just a SIM card.

14. As for claims 8-9 and 18-19, Puhl, Harris and Davis disclose the apparatus of claims 1, 7, and 17, further;

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what Puhl does not clearly disclose is that the recipient-terminal further comprises a card-member receiving platform and wherein said payment indicator comprises a payment card containing the indicia of the creditworthiness of the recipient-terminal user stored thereon, said payment and releasably positionable at the card-member receiving platform to be coupled to said downloading controller when positioned thereat

What Puhl is not explicit about in the above claim is how the Smart Card reader and writer in its portable terminal associated with the rest of the system (See Puhl col. 11, ln. 5-68, col. 12, ln. 1-10) and the nature of the "Smart Card's" value holding (Software Token) and a system that it does utilize to transact the transfer of "electronic cash" from the receiving terminal to the provider terminal. However, both Harris and Davis clearly teach systems that use smart card and cash value stored within them to carry on "electronic cash" transaction and the system to make it easy to read and interact with the (See Harris col. 21, ln. 60-68 and col. 22, ln. 1-55, and Davis figure 32, col. 7, ln. 5-35, col. 11, ln. 14-25, col. 23, ln. 66-68 and col. 24, ln. 1-23). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the two concepts to have a quicker and easier transaction process over an open network with more flexibility and choices.

15. As for claims 10 and 16, Puhl, Harris and Davis disclose the apparatus of claims 1 and 15, further;

what Puhl is not explicit about is that the content has cost indicia associated therewith, the cost indicia indicating a charge associated with execution of the content and wherein said downloading controller compares the cost indicia associated with the content with the indicia of creditworthiness contained at the payment indicator to determine whether the indicia of creditworthiness is at least the selected threshold (See Puhl col. 11, ln. 5-68, col. 12, ln. 1-10). It would have been obvious to one having ordinary skill in the art at the time the current invention was made that in order to render services based on a monetary transaction a system has to be able to check and verify the level of credit available to a transaction to be rendered and make a comparison to see if the available level of monetary funds available would be sufficient to cover the cost of service or content to be provided.

16. As for claims 14 and 20, Puhl, Harris and Davis discloses the apparatus of claim 1, further; what Puhl does not clearly disclose is that the content further has payment account depository indicia associated therewith, the payment account depository indicia indicating the location to which said recipient-terminal downloading connector is to effectuate the communication link and crediting the payee entity for execution of the content at the recipient mobile terminal (See Puhl col. 13, ln. 25-68 and col. 14, ln. 1-12). However, both Harris and Davis clearly indicating the system and method of directing the receiving terminal to provide a third party (Payment Server) of the transaction and the associated information therewith (See Harris col. 23, ln. 65-68 and col. 24, ln. 1-22, and Davis col. 12, ln. 39-61 and col.16, ln. 52-57). Therefore, It would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the teachings of Harris and Davis with Puhl's to achieve greater security and authentication of monetary transaction. (Additionally, it is well known that e-commerce systems do keep track of the customer transactions as specific data related to the transaction within a data base unique to that consumer and based on the information obtained through communications between the two terminals is captured as certain transactions take place. Accordingly the cost associated with the transactions are debited to the recipient of the services credit data just as it is credited to the providers data where ever it might have been stored).

17. As for claim 17, Puhl, Harris and Davis disclose the apparatus of claim 15, further; what Puhl is not explicit about is that the additional operation, prior to said operation of determining, of providing the indicia of creditworthiness to the recipient mobile terminal (See Puhl col. 11, ln. 5-68, col. 12, ln. 1-10). It would have been obvious to one having ordinary skill in the art at the time the current invention was made that in order to render services based on a monetary transaction a system has to be able to check and verify the level of credit available to a transaction to be rendered and make a comparison to see if the available level of monetary funds available would be sufficient to cover the cost of service or content to be provided. In Addition it is well understood in the art that for any transaction to

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take place or any transfer of digital assets to occur a determination is made for credit worthiness of the purchaser.

What Puhl fails to be explicit about in the above claim is how the Smart Card reader and writer in its portable terminal associated with the rest of the system (See Puhl col. 11, ln. 5-68, col. 12, ln. 1-10) and the nature of the "Smart Card's" value holding (Software Token) and a system that it does utilize to transact the transfer of "electronic cash" from the receiving terminal to the provider terminal. However, both Harris and Davis clearly teach systems that use smart card and cash value stored within them to carry on "electronic cash" transaction and the system to make it easy to read and interact with the (See Harris col. 21, ln. 60-68 and col. 22, ln. 1-55, and Davis figure 32, col. 7, ln. 5-35, col. 11, ln. 14-25, col. 23, ln. 66-68 and col. 24, ln. 1-23). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the two concepts to have a quicker and easier transaction process over an open network with more flexibility and choices.

Conclusion

18. Applicant's arguments with respect to claims 1-10 and 14-20 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed on May 17, 2002 have been fully considered and the current office action has not been made final. Claims 11-13 and 21-22 have been canceled and claims 1, 2, 14, and 15 have been amended and examined accordingly.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

James Sachs, U.S. Patent No. 6,331,865, Method and Apparatus For Electronically Distributing and Viewing Digital Contents

Masayuki Ohaki, U.S. Patent No. 6,000,607, IC Card Reader/Writer and Method of Operation Thereof

Donal R. Katz, U.S. Patent No. 5,926,624, Digital Information Library and Delivery System With Logic for Generating Files Targeted to The Playback Device

Robert N. Daggar, U.S. Patent No. 5,748,737, Multimedia Electronic Wallet With Generic Card.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

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or faxed to:

(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]

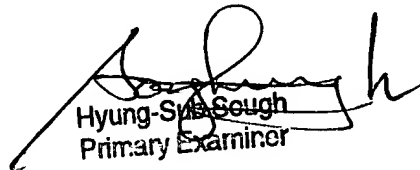
(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

Crystal Park 5, 2451 Crystal Drive

7th floor receptionist, Arlington, VA, 22202

Abdi/K
August 6, 2002


Hyung-Sik Seough
Primary Examiner